

REMARKS

Presently, claims 1-3, 5-8, 10-18 and 22-23 and 25 are pending in the specification. A Request for Continued Examination under 37 CFR 1.114 is being submitted herewith.

Claims 4, 9, 18-21 and 24 have been canceled. Claims 1, 12 and 22 have been amended. Claim 25 has been added. Support for the amendments to independent claims 1 and 22 and the features of new claim 25 may be found, for example, in paragraphs 74-78 and 81-82 of the specification. Claim 12 has been amended correct formal matters noted by Applicants. Accordingly, no new matter has been added by the foregoing amendments.

Prior Art Rejection – 35 USC §103

The Examiner has rejected claims 1-3, 5-20, 22 and 23 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No 5,661,516 to Carles ("Carles") in view of U.S. Patent 5,652,615 to Bryant ("Bryant") and further in view of U.S. Patent 6,985,882 to Del Sesto ("Del Sesto").

Carles teaches a method of providing advertisements to individual subscribers by tagging commercials with routing information and converter addresses. Carles uses a database of "smart" commercials containing embedded information identifying the categories of recipients for the message. The commercials are inserted into the data stream based on a previously created schedule.

Bryant teaches architecture for transmitting programming to customers. In Bryant, "base" and "fill" segments are transmitted concurrently to the customer. The number of fill segments transmitted in one signal is selected based on the bandwidth of the signal. Thus, four 1.5Mb/s segments or two 3.0Mb/s segments may be concurrently transmitted on a 6Mb/s signal. Column 5, lines 4-9.

Del Sesto teaches an advertising marketplace in which a buyer may bid on **particular** avail opportunities. The system of Del Sesto "will display a list of avail sets by station in the selected market and will indicate the day and time, show category, daypart, demographic

information....” Column 6, lines 62-64. The buyer will then “see the seller’s start price for the avail set by station, and will enter in the buyer counter the buyer’s offer for the avail set.”

Column 7, lines 23-25. Thus, in Del Sesto, a seller lists all available ad opportunities and the advertisers choose to bid on one of the listed ad opportunities.

The combination of Carles, Bryant and Del Sesto does not teach or suggest, “presenting a purchase offer for the advertisement opportunity to advertisers associated with the selected two or more targeted advertisements in response to the selecting two or more targeted advertisements, the purchase offer containing the results of the correlation and advertisement opportunity characteristics,” as recited in claim 1. As discussed, Del Sesto presents available ad opportunities to the system at large, and consequently accepts bids from any and all interested parties that are part of the system. Conversely, the claimed subject matter presents the purchase offer to the advertisers associated with the selected advertisements, effectively pre-selecting avails / advertisement opportunities to advertisers that have ads relevant to the available ad opportunities. Stated differently, unlike in Del Sesto, in independent claim 1 only a certain subset of advertisers that may have submitted a request for advertisement presentation would receive the purchase offer. Thus, Del Sesto does not teach or suggest this feature. Neither Carles nor Bryant makes up for this shortcoming of Del Sesto, as neither reference is concerned with presenting purchase offers for advertisement opportunities. Accordingly, the combination of Carles, Bryant and Del Sesto does not teach or suggest all features of independent claim 1.

The combination of Carles, Bryant and Del Sesto does also not teach or suggest, “receiving a plurality of requests for advertisement presentation, each request associated with an advertisement and...wherein each of the plurality of requests may be fulfilled by inserting the associated advertisements into one of a plurality of available advertisement opportunities,” as recited in claim 1. In Del Sesto, advertisers request specific advertisement avails by placing bids; the requests are only fulfilled by inserting the associated advertisement into the avail that an advertiser has selected if he placed the winning bid. Additionally, neither Carles nor Bryant teaches this feature, as the references are concerned with the actual insertion of advertisements and delivery of the advertisements to the subscriber. Thus, the combination may only place advertisements into specific ad slots as bid on by the buyers. However, in the present claim, requests for advertisement insertion are not immediately associated with a bid for a particular

time slot. Therefore, the requests may be fulfilled by inserting the associated advertisements into one of a plurality of available advertisement opportunities, depending, for example, on which ad slot(s) or avail(s) are best suited for that advertisement.

Furthermore, the proposed combination of Carles with Bryant and Del Sesto is improper. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); MPEP § 2143.01. More specifically, Carles teaches inserting advertisements based on a previously created schedule. Bryant teaches that the number of fill segments transmitted in one signal are selected based on the bandwidth of the signal (e.g., four 1.5Mb/s segments or two 3.0Mb/s segments may be concurrently transmitted on a 6Mb/s signal). However, Del Sesto accepts all bids without taking into account the bandwidth of the advertisements. While Del Sesto may teach the concept of rejecting bids generally, it does not describe on what basis such bids may be rejected. Thus, any winning bids in Del Sesto would necessarily be fulfilled without any knowledge as to the bandwidth requirements of the advertisements and/or the available bandwidth of the corresponding avail into which the winning advertisement will be inserted. Therefore, Carles could not properly be modified with both the teaching of Del Sesto and the teaching of Bryant as the modified system would not be able to select advertisements based on the bandwidth as required by a combination of Carles and Bryant. Additionally, none of Carles, Bryant or Del Sesto teaches or suggests pre-selecting advertisements based on their bandwidth requirements prior to transmitting a purchase offer for the advertisement. Therefore, it cannot be properly said that it would be obvious to combine Carles, Bryant and Del Sesto, as the proposed combination would be inoperable.

Applicants respectfully submit that independent claims 22 and 25 are patentable over the prior art at least in part based on reasons similar to those discussed above with respect to independent claim 1. Accordingly, independent claims 22 and 25 are believed to be allowable over the proposed combination of Carles in view of Bryant, in further view of Del Sesto.

Accordingly, since the combination of Carles, Bryant and Del Sesto is improper and does not teach or suggest all elements of the independent claims, Applicants respectfully submit that

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independent claims 1, 22 and 25 are allowable over the combination of Carles, Bryant and Del Sesto. Dependent claims 2, 3, 5-8, 10-18 and 23 are allowable at least by their dependency on independent claims 1 and 22, respectively.

Conclusion

In view of the foregoing remarks, Applicants respectfully submit that the Examiner's rejection has been overcome, and that the application, including claims 1-3, 5-8, 10-18, 22-23 and 25 is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejection and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

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